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09/752,666	12/28/2000	Frank Liebenow	257/020	4510

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EXAMINER	
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ART UNIT	PAPER NUMBER
2153	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/752,666	LIEBENOW, FRANK	
	Examiner	Art Unit	
	Aaron Strange	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,7-12,14,15,17,18,21-28 and 30-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,7-12,14,15,17,18,21-28 and 30-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/7/2007 have been fully considered but they are not persuasive.

2. With regard to Applicant's assertion that "the order of the entering step with respect to the browsing step and the storing step that is required by the language of claim 1 (and claim 12) is significant and produces results that would not be expected from the Adams system" (Remarks, 10), the Examiner respectfully disagrees.

3. Applicant acknowledges that Adams teaches designating "keep documents" when the document is requested (Remarks, 11), and acknowledges that Adams teaches designating documents already stored as "keep documents" (Remarks, 11). Applicant additionally argues that since "the user is thus not forced to predict that the data will be worth storing ... nor required to save the data before indicating that the data should be stored for a minimum length of time", this specific order of steps "produces a **more usable** result that is disclosed by or evident from the Adams system" (emphasis added)(Remarks, 12).

4. Each of the three relevant steps, (a) receiving the document, (b) designating the document as a keep document (obtaining step), and (c) storing the document, are performed by Adams. Since the storing step must occur after the receiving step, there

are three possible orders (a), (b), (c); (b), (a), (c); and (a), (c), (b). Adams explicitly discloses two of those, as discussed above and in the rejection presented below. The third, (a), (b), (c), is not explicitly disclosed, and corresponds to the claim language of all pending claims.

While the Examiner agrees that Adams fails to explicitly teach designating a document as a "keep document" after it has been received but prior to being stored for a time indicated by a user, performing the steps in that order would not produce **unexpected** results. In this case, the fact that the results may be "more usable" does not mean they are unexpected, and Applicant has provided no evidence or even argument purporting to show that the claimed order produces unexpected results.

The advantages of performing the steps in the claimed order, listed by Applicant, are not "results", nor are they unexpected. It is respectfully submitted that one of ordinary skill in the art, when required to make a determination regarding when to obtain, from a user, an indication of a minimum length of time to store a document, would have seen a benefit to obtaining it after receiving the document but before storing it. This would have allowed the user to review the document prior to deciding whether to keep it, and such a benefit would have been entirely expected.

5. Additionally, Adams teaches that a document may be designated as a "keep document" "[a]t the time of the request" (Col. 3, Lines 12-16). This language does not explicitly specify an ordering and is sufficiently general to suggest to one of ordinary skill in the art that the designation could occur after the document has received in the

browser, but before being stored in the cache. Since the time difference between requesting and receiving a document via the network is typically less than several seconds, the designation would still occur substantially "[a]t the time of the request", but occur immediately following it. One of ordinary skill in the art, upon learning of Adams' disclosure, would have recognized that designating a document as a keep document immediately following the receipt of the document would have been a predictable variation of the explicitly disclosed embodiments.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 2, 7, 8, 12, 14, 15, 17, 18, 21-26, 29-32 rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (US 5,873,100).

8. **With regard to independent claim 1**, Adams discloses a method comprising the steps of:

receiving, by a client system, in response to a request by a user of the client system, data from a network in a distributed system (Col 3, Lines 47-49 and 62-65);

obtaining, by said client system from the user of the client system, an indication of a minimum length of time during which the received data is to be temporarily stored (Col 3, Lines 22-26); and

storing temporarily on the client system at least a portion of the received data for a period of at least the minimum length of time indicated by the user at the client system (document remains a keep document for at least the time period and only non-keep documents are deleted)(Col 3, Lines 66-67 and Col 4, Lines 3-4);

wherein the obtaining step is performed after the receiving step (documents which are already received may be indicated as keep documents) (Col 3, Lines 18-20).

Adams fails to specifically disclose the specific ordering of the steps where the obtaining step is performed after the receiving step and before the storing step. Rather, Adams discloses that the obtaining step is performed "[a]t the time of" (Col 3, Lines 12-16) the browsing step.

In the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to reverse of the order of steps in the claimed process. For example, in *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959), the BPAI held that since "It is evident therefore that no unexpected result is obtained by reversing the order of steps recited in the method ...." " the method recited in the appealed claims is not patentable over appellant's patented method." (id., at 442).

This claim is sufficiently similar to the claims at issue in *Ex parte Rubin*. In *Ex parte Rubin*, the claimed method produced a laminated sheet by laminating one side and then putting a metallic film on the other side. It was held to be unpatentable over a

claim directed which placed the metallic film on one side prior to laminating the other side. In that case, the product produced was identical, regardless of the order of the steps, and performing them in either order produced no unexpected results.

In this case, the claim states that the obtaining step is performed after the receiving step and before the storing step. The result of those steps is receipt of an expiration time from the user, allowing the file to be stored for the specified time. Adams discloses that the entering step is performed prior to or simultaneous with the browsing step (Col 3, Lines 15-17), and before the storing step. The result of Adams' steps is exactly the same; receipt of an expiration time from the user, allowing the file to be stored for the specified time. There are no unexpected results arising from reversing the order of the obtaining and receiving steps. Computers are quite predictable and perform only the exact instructions they are told to, and it is apparent that collecting the expiration time from the user prior to or after the receiving step will produce the same results, since they are completely independent operations.

Several other cases support the proposition that the ordering of steps is not patentable, absent some evidence of unexpected results. *See In re Burhans*, 154 F.2d 690, 69 USPQ 220 (CCPA 1946) (holding that the order of steps in making wheat flour is not patentable "in the absence of any proof in the record that the order of performing the steps produces any new and unexpected results"); *In re Gibson*, 39 F.2d 975, 5 USPQ 230 (CCPA 1930) (holding that the order of mixing ingredients as an "obvious and practical operation"); *In re Lang et al.*, 97 F.2d 626, 38 USPQ 187 (CCPA 1938) (holding that arranging known steps in a particular order "would not amount to

invention"). *See also In re Peddrick, Jr. et al.*, 48 F.2d 415, 9 USPQ 269 (CCPA 1931) (finding patentable a new arrangement of steps that produced "new and useful results", but noting that arrangements which produce obvious results are "not the result of invention").

Additionally, as discussed above in the response to arguments, the language used by Adams "[a]t the time of" is sufficiently general to suggest to one of ordinary skill in the art that the designation of a document as a keep document could occur immediately after receiving the requested document. Since documents are typically retrieved by Internet browsers within seconds, obtaining the designation after the document was received by the browser would still substantially be "[a]t the time of" the request, and would be a predictable variation of the explicitly disclosed ordering.

9. With regard to claim 2, Adams further discloses that the received data is stored in a memory space accessible by the client system as cache (Col 3, Lines 66-67).

10. With regard to claim 7, Adams further discloses the step of designating, on said client system, that the received data be temporarily stored (Col 3, Lines 25-28), wherein the designating step includes a step of presenting a user with a window for user input (Col 3, Lines 12-20).

11. With regard to claim 8, Adams further discloses that the obtaining step is carried out by a user in real time (time is obtained when document is indicated as a keep document)(Col 3, Lines 18-20).

12. With regard to claim 21, Adams further discloses inquiring of the user of the client system whether the received data should be temporarily saved (Col 3, Lines 12-16 and 22-28).

13. With regard to claim 22, Adams further discloses receiving an indication from the user that the at least a portion of the received data is to be temporarily stored (user designates a keep document) (Col 3, Lines 12-16 and 22-28).

14. With regard to claim 23, Adams further discloses prompting the user of the client system to enter the minimum length of time to temporarily store the received data (keep documents may be time limited)(Col 3, Lines 22-28).

15. With regard to claim 24, Adams further discloses accepting from the user of the client system the indication of the minimum length of time (Col 3, Lines 22-28).

16. With regard to claim 25, Adams further discloses deleting from storage at least a portion of the received data on a first in/first out basis upon the passage of the minimum length of time indicated by the user (Col 4, Lines 3-4).

17. With regard to claim 26, Mantha further discloses providing the user of the client system with an option to delete an earlier version of the received data being stored (any saved pages can be deleted) (Col 9, Lines 38-49).

18. With regard to claim 29, Adams further discloses that the step of obtaining the indication of the minimum length of time occurs after the receiving step of receiving the requested data (Col 3, Lines 18-20).

19. With regard to claim 30, Adams further discloses that the minimum length of time received from the user is applied only to the received data (keep documents are individually designated)(Col 3, Lines 12-16).

20. With regard to claim 31, Adams further discloses that the client system erases only the particular received data after the minimum length of time received from the user (document will revert to being a non-keep document, which is deleted when the cache fills) (Col 3, Lines 27-28 and Col 4, Lines 3-5).

21. **With regard to independent claim 12**, Adams discloses a method comprising the steps of:

browsing by a user at a client in order to locate Web page data associated with a specific Web page (Col 3, Lines 47-49 and 62-65);

at said client, entering a time specified by the user for the Web page data associated with the specific Web page (Col 3, Lines 22-26);

storing said Web page data for the specific Web page temporarily in a cache (all documents are stored temporarily)(Col 3, Lines 66-67);

after said user specified time period, deleting the Web page data for the specific Web page from said cache (after document reverts to non-keep, it will be deleted when the cache fills)(Col 4, Lines 3-4);

Adams fails to specifically disclose the specific ordering of the steps where the entering step is performed after the browsing step and before the storing step. Rather, Adams discloses that the entry is made "[a]t the time of" (Col 3, Lines 12-16) the downloading step.

The remaining rationale for the rejection of claim 12 mirrors that set forth above for claim 1. In the interest of brevity, that discussion will not be repeated here.

22. **With regard to independent claim 14**, Adams discloses a client, comprising:

a central processing unit (Col 1, Lines 46-63);

an input device coupled to the central processing unit (Col 1, Lines 46-63);

an output device coupled to said central processing unit (Col 1, Lines 46-63); and

a memory space operatively coupled to said central processing unit for storing data (Col 1, Lines 46-63),

the client being configured to temporarily store data downloaded from a network

for a minimum period of time specified by a user, after which period of time the stored data is subject to automatic deletion(document remains a keep document for at least the time period and only non-keep documents are deleted)(Col 3, Lines 66-67 and Col 4, Lines 3-4), said user specified minimum period of time being specified by an entry made at said input device by the user (Col 3, Lines 22-26) after the data is downloaded (documents which are already received may be indicated as keep documents) (Col 3, Lines 18-20);

wherein the stored data represents a particular Web site image downloaded from the network (Col 3, Lines 47-49 and 62-65) and the user-specified minimum period of time is associated with the stored data of the particular Web site image only (Col 3, Lines 6-11).

Adams fails to specifically disclose the specific ordering of the steps where the entry made at said input device by the user occurs after the data is downloaded and before the data is stored. Rather, Adams discloses that the entry is made "[a]t the time of" (Col 3, Lines 12-16) the downloading step.

The remaining rationale for the rejection of claim 14 mirrors that set forth above for claim 1. In the interest of brevity, that discussion will not be repeated here.

23. With regard to claim 15, Adams further discloses that the memory space is a cache memory space (Col 3, Lines 66-67).

24. With regard to claim 17, Adams further discloses that the client is further configured to respond to a user request to display information about the stored data (display keep status of the documents so user may delete them) (Col 4, Lines 9-15).

25. With regard to claim 18, Adams further discloses that the client is further configured to respond to a user request to modify a property of the stored data (existing documents may be designated as keep documents) (Col 3, Lines 18-20).

26. **With regard to independent claim 32**, Adams discloses a method comprising the steps of:

receiving, by a client system in response to a request by a user of the client system, data for an individual Web page, from a network in a distributed system (Col 3, Lines 47-49 and 62-65);

obtaining, by said client system from the user of the client system and after receiving the data of the individual Web page (Col 3, Lines 18-20), an indication of a minimum length of time during which the received data for the individual Web page is to be temporarily stored on the client system (all documents are stored temporarily)(Col 3, Lines 22-26); and

storing temporarily at least a portion of the received data for the individual Web page on the client system for a period of at least the minimum length of time (Col 3, Lines 66-67);

deleting the received data for the individual Web page from the client system after at least the minimum length of time (after document reverts to non-keep, it will be deleted when the cache fills)(Col 4, Lines 3-4).

Adams fails to specifically disclose the specific ordering of the steps where the obtaining step is performed after receiving the data of the individual Web page and before storing the received data. Rather, Adams discloses that the obtaining step is performed "[a]t the time of" (Col 3, Lines 12-16) the receiving step.

The remaining rationale for the rejection of claim 32 mirrors that set forth above for claim 1. In the interest of brevity, that discussion will not be repeated here.

27. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (US 5,873,100) in view of Lambert et al. (US 6,038,601).

28. With regard to claim 9, while the system disclosed by Adams shows substantial features of the claimed invention (discussed above), it fails to disclose reading an instruction provided with the received data, wherein the instruction indicates that the received data should be temporarily stored.

Lambert discloses a similar system for saving web pages on a local cache. Lambert teaches reading an instruction provided with the received data, wherein the instruction indicates that the received data should be temporarily stored (Section 3.4; Col 12, Lines 49-67). Lambert teaches that the content provider may provide an expiration date with served content, and the local cache will serve content from the local

cache until the expiration date has passed. At that time, it will check with the server to determine if the content has changed. This would have been an advantageous addition to the system disclosed by Adams since it would have allowed the content provider to inform the user when the served content is likely to have changed, giving them the opportunity to check for updates if desired.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include an instruction with the received data that indicates that the received data should be temporarily stored, since it would have informed the user when the content provider expects the data to have changed, giving them the opportunity to check for updates.

29. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (US 5,873,100) in view of Blendermann et al. (US 6,789,161).

30. With regard to claim 10, while the system disclosed by Adams shows substantial features of the claimed invention (discussed above), it fails to disclose deleting the data immediately after the specified minimum length of time has passed.

Blendermann discloses a system for temporary storage of files. Blendermann teaches allowing the user to specify that files be immediately deleted upon the passage of their expiration time (at least Col 3, Lines 16-22). Upon passage of the expiration time, the files will be immediately deleted. This would have been an advantageous

addition to the system disclosed by Adams since it would have improved the efficiency of the storage space by removing the expired files.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the stored pages immediately upon expiration of the minimum length of time since it would have freed up cache space and removed unwanted data, increasing the number of pages that the user may store in cache.

31. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (US 5,873,100) in view of Porter (US 6,476,827).

32. With regard to claim 11, while the invention disclosed by Adams shows substantial features of the claimed invention (discussed above), it fails to disclose that the data is a first Web page containing a hyperlink to a second Web page and the storing step includes storing data of the second Web page.

Porter discloses a similar system for saving web pages to a client. Porter teaches traversing the hyperlinks of a first page to retrieve the pages the links point to and saving them in addition to the original page (Col 5, Line 64 to Col 6, Line 1). This would have been an advantageous addition to the system disclosed by Adams since it would have ensured that pages referenced in the parent page would also be available to the user during the specified time period.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the web pages linked to by the parent web page

when saving a page at the client. Since the pages linked to by the parent page are likely related and of interest to the user, this would have ensures that the pages linked to by the parent page would be available to the user during the specified time period.

33. Claims 27 and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over Adams et al. (US 5,873,100) in view of Reinhardt (US 5,680,609).

34. With regard to claims 27 and 28, while the system disclosed by Adams shows substantial features of the claimed invention (discussed above), it fails to disclose notifying the user of the client system prior to deleting the received data or deleting the data after being authorized by the user.

Reinhardt discloses a method for deleting files from a computer system. Reinhardt teaches providing the user with the option of requiring that the user be asked for permission to delete files scheduled for deletion (at least Col 7, Lines 26-50). This would have been an advantageous addition to the system disclosed by Adams since it would have allowed the user to stop deletion of any file if they decided to keep it.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to notify the user that the expiration period has expired and obtain permission to delete the expired files prior to deleting them. This would have allowed the user to stop deletion of any file that they still wanted to keep.

Conclusion

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS
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